

REMARKS

Claim 33 has been amended to make explicit what was implicit, that is to recite a method of identifying a compound that “stimulates or inhibits axonal growth of a central nervous system neuron” using *bovine* N-Kinase. Claim 33 has further been amended to include steps c) and d), wherein step c) recites, “contacting a central nervous system neuron, *in vitro*, with said selected test compound” and step d) recites, “identifying a compound that stimulates or inhibits axonal outgrowth of the central nervous system neuron”. Support for this amendment is found throughout the specification and in the claims as originally filed, specifically in **original claim 30** that recites “a method for identifying a compound that modulates axonal outgrowth of a central nervous system neuron...” and at page 6, lines 12-18 and page 8, lines 3-6, wherein “modulating” is defined to include the capacity to “stimulate” or “inhibit” axonal outgrowth of central nervous system neurons; and in original claim 33 that was dependent upon claim 30. Specific support for the recitation of steps c) and d) in claim 33 is found in **original claim 46** and at page 15, lines 23-38, wherein it is stated, “In another embodiment, the method of the invention further includes determining the ability of the test compound to modulate axonal outgrowth of a central nervous system neuron.” Further, at page 16, lines 5-6, it is stated that an extension of a neuronal process five cell diameters in length is used as a criterion for growth. No new matter has been added by virtue of the claim amendments.

Claim Rejections

Claim 33 has been rejected under 35 U.S.C 103(a) as being unpatentable over Zhou et al., J. Biol Chem. 275(4); 2513-2519.

The Applicant has amended claim 33 to recite the steps of c) contacting a central nervous system neuron, *in vitro*, with said selected test compound; and d) identifying a compound that stimulates or inhibits axonal outgrowth of the central nervous system neuron. The Applicant respectfully submits that Zhou et al. does not suggest contacting a central nervous system neuron, *in vitro*, with a selected test compound for identification of identifying a compound that stimulates or inhibits axonal outgrowth of the central nervous system neuron. Nor would such a

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step be obvious in light of Zhou et al., which merely relates to identification of a kinase isoform. Accordingly, the Applicant respectfully submits that the claim amendments have obviated this rejection and respectfully request withdrawal of the rejection.

Claims 58, 32, 36, and 37 have been rejected under 35 U.S.C 103(a) as being unpatentable over Volante et al., J. Cell Biology 109:2395-2403 Nov. 1989 in view of Zhou et al., J. Biol. Chem. 275 (4): 2513-2519 and Benowitz et al. J. Biol. Chem 273 (45): 29626-29634, Nov. 1998.

The Applicant submits that this rejection should be withdrawn for the following reason. Applicant submits that there is no motivation to combine Zhou et al. with either Benowitz et al. or Volante et al. because there is no teaching in Zhou et al. of an involvement of their N-Kinase with axonal growth. One skilled in the art would not necessarily assume that the rat kinase of Benowitz and human kinase of Zhou would behave the same. The Federal Circuit has long held that "obvious to try" does not constitute "obviousness." The court (*In re O'Farrell* 853 F.2d 894, 7 U.S.P.Q.2d 1673 (Fed. Cir. 1988)).

Accordingly, the Applicant respectfully requests that the rejection of claims 58, 32, 36, and 37 under 35 U.S.C 103(a) be withdrawn.

In view of the foregoing, Applicant respectfully requests favorable reconsideration of the application.

A Petition for a THREE Month Extension of time is submitted herewith. If any additional extension of time for the accompanying response is required, Applicant requests that this be considered a petition therefore.

The Examiner is authorized to charge any fee deficiencies or credit any overpayments associated with this submission to the Nixon Peabody LLP Deposit Account No. 50-0850.

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The Examiner is invited to contact the undersigned if further matters need to be discussed in order to expedite the prosecution of the present application.

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Respectfully submitted,



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